

Application No. 10/772,823
Docket No. 2000U042D1-CON2
Reply to Office Action Dated 12/09/2004

Remarks

Amendments

For purposes of clarity, Claim 1 is amended by inserting the phrase --at least one comonomer unit selected from the group consisting of--. No new matter is added.

Claim 13 is also amended for sake of clarity by deleting the term "further".

Also for purposes of clarity, Claim 15 is amended by deleting the word "is" and "combined". No new matter is added.

Section 102/103 Rejections

The Examiner maintains the rejection of Claims 1-15 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Brady, III et al. (US 5,317,036) (hereinafter "*Brady*"). The Applicant traverses these rejections, as the Examiner is applying an incorrect legal standard for inherency.

The Examiner states that

in view of substantially identical monomeric compositions and substantially similar catalyst system between the claimed invention and the disclosure in Brady, III et al., the examiner has a reasonable basis to believe that the density, molecular weight properties of the polymers, the sieved neat polymer fraction obtained from specific mesh sieve sizes having a specific I₂ values, WPR or bimodal polymers being claimed are inherently possessed by the disclosure to Brady, III et al. (emphasis added)

The Applicant contends that the legal standard for inherent anticipation is not one of having "a reasonable basis to believe" that the claim limitations are "inherently possessed" by a disclosure. The standard is outlined in the MPEP § 2112, which states in part that

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 50-51 (Fed. Cir. 1999). (citations omitted) (emphasis added).

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The MPEP establishes that the Examiner must provide "extrinsic evidence" that makes clear that the missing feature(s) are "necessarily present". The Examiner has made no such case, and in fact, uses reasoning wherein "a certain thing may result from a given set of circumstances", which is recognized in the MPEP as "not sufficient".

Again, in *In re Best*, cited by the Examiner, the court found that the Examiner had outlined a technical rational derived from specific information disclosed in the prior art in order to find inherency for one particular claim limitation, the remaining limitations having been shown to be explicitly disclosed in the prior art. The court in *Best* upheld the Examiners finding of inherency because the Examiner had demonstrated, using an objective technical rational, how the claim element at issue was disclosed by, and necessarily flows from, the prior art. The Examiner here has not elucidated with extrinsic evidence a valid rational for inherency but has instead impermissibly relied upon "a reasonable basis to believe" standard that the claim limitations at issue are inherently disclosed. This contravenes the MPEP § 2112 standard that the Examiner may not rely upon "[t]he mere fact that a certain thing may result from a given set of circumstances". The Examiner must go further and show that the Claim limitation at issue "necessarily" follows from *Brady*. That has not been done.

Furthermore, the Examiner here is inferring all but one ("ethylene derived units and C₄ to C₁₂ α -olefin derived units") of the Claim 1 limitations from *Brady*. *See* First Office Action dated September 9, 2004. The opposite is true in *Best*, where the Examiner found explicit disclosures for each claim element of the claim at issue except for one element. And even that one limitation cited by the Examiner in the current case, the "ethylene derived units and C₄ to C₁₂ α -olefin derived units" phrase, is a modifier for "bimodal polyolefin" which is not explicitly or inherently disclosed in *Brady*.

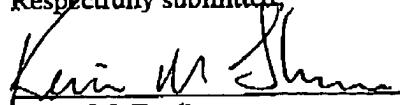
Further, Applicant wishes to state that, contrary to the Examiner's assertion that "the catalyst of *Brady*, III et al. is a single metallocene while the applicants polymers are prepared with two or more catalysts", the Applicant only stated as an example that the polymer could be prepared by using two or more catalysts. The invention as claimed, as admitted by the Examiner, is not so limited.

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Given the fact that *Brady* does not disclose all the features of Claim 1 either explicitly or inherently, the Claims are not anticipated or obvious, and the Applicant urges reversal of all claim rejections.

Respectfully submitted,

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